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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Luca Morlacchi

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EXAMINER

AZIZ, KEITH T

ART UNIT

PAPER NUMBER

1791

NOTIFICATION DATE

DELIVERY MODE

06/19/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

info@lmiplaw.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/559,967	<b>Applicant(s)</b> MORLACCHI, LUCA	
	<b>Examiner</b> KEITH T. AZIZ	<b>Art Unit</b> 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 13-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 4-12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Election/Restrictions***

1. Claims 13-48 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 5/19/2009.
2. Applicant's election with traverse of claims 1-12 in the reply filed on 5/19/2009 is acknowledged. The traversal is on the ground(s) that the special technical feature of the present invention is the waterproofing of semi-manufactured items, and that the products are necessarily obtained through the process of the elected group. This is not found persuasive because international application WO 02/11571 teaches waterproofing semi-manufactured items (see Title, Abstract, and lines 7-8 of page 1). Furthermore, the products made by the process of WO 02/11571 are equivalent to the products of Groups II, III, and IV.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Objections***

3. Claims 2-3 objected to because of the following informalities: Claim 2 should read "process according to claim 1", instead of "process according to the previous claim". Claim 3 should read "process according to claim 1 or claim 2", instead of "process according to one of the previous claims". Appropriate correction is required.

4. Claims 4-12 objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend on another multiple dependant claim. Claim 4 depends on claim 3, which is a multiple dependant claim, and each subsequent claim depends on a claim with issues concerning improper multiple dependant claim forms. See MPEP § 608.01(n). Accordingly, the claims 4-12 have not been further treated on the merits.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3 are rejected under 35 U.S.C. 102(b) as anticipated by international patent application WO 02/11571 (Morlacchi hereafter).

Morlacchi discloses a process and device for water-proofing semi-manufactured articles (see title, as well as Abstract). Morlacchi teaches that a semi-manufactured with a three dimensional shape and an inner and outer surface (see lines 7-9 of page 3) is arranged onto a shaped support (see lines 18-22 of page 3). Morlacchi also teaches at least one waterproofing sheet with a layer of glue arranged between the sheet and the product is used to cover the product (see lines 27-30 of page 3). Morlacchi further

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teaches that the product, which is arranged around the shaped support, is water-proofed through pressing the waterproof sheet between two deformable pressing plates (see lines 16-19 of page 2, as well as Figures 6 and 7). Morlacchi teaches that the waterproof sheets are folded and flattened if they extend beyond the size of the semi-manufactured product (see lines 7-9 of page 2), and that after folding the sides adhere to one another to form at least two strips that seal the product during pressing (see lines 10-13 of page 2).

While Morlacchi does not explicitly state that the waterproof sheets are shaped in a three-dimensional conformation similar to that of the product, the shape of the folded waterproof sheet would be inherently be similar to the shape of the product and possess three dimensions. All objects with a length, width and height possess three dimensions, and the waterproof sheets inherently have a length, width and height. Additionally, as the waterproofing sheets are being placed on the product on the shaped support, the sheets would inherently have the same or similar shape to the semi-manufactured product.

With regard to claim 2, Morlacchi teaches that the glue is a thermoactive glue (see lines 29-30 of page 3) and that the glue is heated during pressing (again, see lines 29-30 of page 3). Morlacchi further teaches that the glue joins the waterproof sheets to the semi-manufactured product (see lines 30-31 of page 3, as well as lines 1-2 of page 4).

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With regard to claim 3, Morlacchi teaches that the three dimensional semi-manufactured product is turned 'inside-out', such that the inner surface is turned outwards (see lines 6-10 of page 3).

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following documents are cited to show the state of the art with respect to waterproofing clothing products..

U.S. Patent 6,065,227 to Chen, drawn to a waterproof foot covering.

U.S. Patent 5,244,716 to Thornton et al, drawn to a process for making articles made from stretchable fabrics.

U.S. Patent 6,497,786 to Kilgore, drawn to a method and apparatus for bonding deformable materials.

U.S. Patent 2,211,247 to Victor, drawn to metal gasket sealant.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEITH T. AZIZ whose telephone number is (571)270-7658. The examiner can normally be reached on Monday through Thursday 8:00am-6:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Phillip Tucker can be reached on (571)272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KTA/

/KHANH NGUYEN/  
Primary Examiner, Art Unit 1791